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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ya-Tien Ko

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EXAMINER

ANWAH, OLISA

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/057,889

Applicant(s)

KO ET AL.

Examiner

Olisa Anwah

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 14-17, 25-28 and 38-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-9, 11-13, 18-22, 24, 29-33, 35-37 and 42-46 and 48-54 is/are rejected.
- 7) ☐ Claim(s) 10, 23, 34 and 47 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Objections

1. All independent claims are objected to because of the following minor informalities: The acronym LDAP must be spelled out. Appropriate correction is required.

2. Claim 11 is objected to because it is identical to claim 7. Claims 20+24 and 31+34 have the same problem.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant broadly claims, "**the device** is integrated within the telephony device". Applicant does not explicitly specify what the device is. The present claim language raises the following issues: Does the integrated device

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refer to the destination device claimed in claim 9? Is the integrated device the telephony device indicated in claim 5? Or is the integrated device the recording device (see Figure 2A of Applicant's specification)? Applicant is advised to replace "the device" with "the **recording device**". Claims 10, 23, 34 and 47 have the same problem.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

6. Claims 5, 7-9, 11-13, 18, 20-22, 24, 29, 31-33, 35-37, 42, 44-46, and 48-54 are rejected under 35 U.S.C. § 102(e) as being anticipated by Ranalli et al, U.S. Patent No. 6,539,077 (hereinafter Ranalli).

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Regarding claim 5, Ranalli discloses a method in a recording device (26) at a calling party premises (col. 8, lines 1-5), the method comprising:

recording a message by a calling party (col. 8, line 31) based on speech signals supplied by a telephony device (2) configured for initiating a voice-grade media connection to a messaging subscriber (3);

retrieving, via an Internet Protocol (IP) data network (10), messaging subscriber attributes (Figure 2) specifying a destination message store for the messaging subscriber, the retrieving step including sending (col. 8, lines 35-37) onto the IP network an open-protocol query according to LDAP protocol (15) for the messaging subscriber attributes to a server (12) configured for storing messaging subscriber attributes, based on a dialed number input by the calling party (col. 8, line 30); and

sending the recorded message, via the IP data network, to the destination message store based on the messaging subscriber attributes (col. 8, lines 37-40).

Regarding claim 7, see col. 8, lines 25-45 and Figure 2.

Regarding claim 8, see column 3.

Regarding claim 9, see unit 12.

Claim 11 is rejected for the same reasons as claim 7.

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Claim 12 is rejected for the same reasons as claim 8.

Regarding claim 13, see columns 3 and 15.

Regarding claim 18, Ranalli discloses a device (26) coupled to a telephony device (2) at a calling party premises (col. 8, lines 1-5), the device comprising:

- a media circuit configured for storing speech signals supplied by the telephony device as a recorded message configured for storage on a tangible medium (col. 8, line 31);

- a messaging subscriber resource configured for identifying a destination message store, for delivery of the recorded message to a messaging subscriber (3), based on inputs (col. 8, line 30) to the telephony device by a calling party (1) and retrieval, via an Internet Protocol (IP) data network (10), of messaging subscriber attributes (see Figure 2) specifying the destination message store, the messaging subscriber resource configured for sending onto the data network an open-protocol query according to LDAP protocol (see Figures 6 and 7) for the messaging subscriber attributes to a server (12) configured for storing messaging subscriber attributes, based on a dialed number input by the calling party (col. 8, line 30); and

- an IP network interface for sending the recorded message, via the IP data network, to the destination message store based on the messaging subscriber attributes (col. 8, lines 37-40).

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Claim 20 is rejected for the same reasons as claim 7.

Claim 21 is rejected for the same reasons as claim 8.

Claim 22 is rejected for the same reasons as claim 9.

Claim 24 is rejected for the same reasons as claim 20.

Claim 29 is rejected for the same reasons as claim 18.

Claim 31 is rejected for the same reasons as claim 20.

Claim 32 is rejected for the same reasons as claim 21.

Claim 33 is rejected for the same reasons as claim 22.

Claim 35 is rejected for the same reasons as claim 31.

Claim 36 is rejected for the same reasons as claim 32.

Claim 37 is rejected for the same reasons as claim 13.

Claim 42 is rejected for the same reasons as claim 1.

Claim 44 is rejected for the same reasons as claim 31.

Claim 45 is rejected for the same reasons as claim 32.

Claim 46 is rejected for the same reasons as claim 33.

Claim 48 is rejected for the same reasons as claim 44.

Claim 49 is rejected for the same reasons as claim 45.

Claim 50 is rejected for the same reasons as claim 37.

Regarding claim 51, see Figures 1 and 3.

Regarding claim 52, see Figures 1 and 3.

Regarding claim 53, see Figures 1 and 3.

Regarding claim 54, see Figures 1 and 3.

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Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6, 19, 30 and 43 are rejected under 35 U.S.C § 103(a) as being unpatentable over Ranalli in view of Matthews et al, U.S. Patent No. 4,757,525 (hereinafter Matthews).

Regarding claim 6, Ranalli discloses the device is coupled to the telephony device (see Figures 1 and 3). Ranalli fails to teach selectively playing the recorded message based on calling party commands, for review by the calling party prior to the sending step. However Matthews discloses this limitation (see Figure 34). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Ranalli with the calling party commands taught by Matthews. This modification provides the user with the versatility to manipulate the contents of the message as suggested by Matthews (column 84).

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Claim 19 is rejected for the same reasons as claim 6.

Claim 30 is rejected for the same reasons as claim 19.

Claim 43 is rejected for the same reasons as claim 30.

Allowable Subject Matter

9. Claim 10, 23, 34 and 47 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Ranalli discloses the recording device is a PBX and the telephony device is a telephone. It is impossible to integrate a PBX within a telephone. Hence Ranalli teaches away from a method of claim 9, wherein the **recording device** is integrated within the telephony device.

Response to Arguments

10. Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa

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Anwah whose telephone number is 703-305-4814. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 703-305-4895. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

OA ✓
Olisa Anwah
Patent Examiner
August 5, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

